

Appl. No. 10/245,178
Amdt. dated January 11, 2005
Reply to Office Action of October 20, 2004

REMARKS

This is responsive to the Office Action dated October 20, 2004 in which claims 2, 5, 11, 13, 16 and 22-24 were allowed and claims 25-26 merely objected to as being dependent upon a rejected claim, but otherwise allowable. Applicant greatly appreciates the favorable treatment of these claims.

Claims 1,3,4,6-10,12,14,15,17-21 and 27-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,265,283 issued to Farquhar in view of U.S. Patent No. 5,249,681 issued to Miller.

In order to expedite the prosecution of this application toward allowance and issuance, Applicant has amended the rejected and dependent claims 9,14,15,17,18,20, and 27-30 to depend directly from allowed claims 2 or 13. Claims 8,10,19, 21 and 25-26 depend indirectly from claim 2 or 13. As a result, Applicant respectfully asserts that based on the allowance of the claims in the Office Action, that claims 2-11, 13-30 as presented herein are allowable.

Independent claims 1 and 12 stand rejected under Farquhar '283 in combination with Miller '681 as allegedly being obvious. The rejection alleges that it would have been obvious to provide the carton of Farquhar with at least one arcuate corner as taught by Miller '681. Applicant respectfully asserts that the Office Action does not present a *prima facie* case of obviousness and, therefore, is not a valid rejection under § 103 because one of ordinary skill in the art would not find it obvious to

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combine the prior art as suggested in the Office Action. More specifically, the cited reference of Miller '681 teaches away from such combination.

In *U.S. v. Adams*, 383 U.S. 39, 148 USPQ 479 (1966), the U.S. Supreme Court held that one important indicium of non-obviousness is "teaching away" from the claimed invention by the prior art. In short, teaching away from the claimed invention is the antithesis of the prior art suggesting that the person of ordinary skill go in the claimed direction. Teaching away from the claimed invention in the prior art is a per se demonstration of a lack of *prima facie* obviousness. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). When the claimed invention goes in a direction contrary to the accepted wisdom as taught in the prior art, this is "strong evidence of non-obviousness and a § 103 rejection is improper." *In re Hedges*, 783 F.2d 1038, 228 USPQ 685, 687 (Fed. Cir. 1986), see also *In re Nielson*, 816 F.2d 1567, 2 USPQ2d 1525 (Fed. Cir. 1987).

With all due respect, Applicant asserts that the applied references of Farquhar '283 and Miller '681 actually teach away from Applicant's inventions of claims 1 and 12 and, therefore, combining these references to reject these claims is inappropriate. Where the prior art suggests that a particular combination was ill-advised, the reference could not be used to render obvious an operable combination involving the same features. *U.S. v. Adams*, 148 USPQ at 483.

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Specifically, the Miller '681 reference teaches directly away from a dispenser opening in the end wall adjacent an arcuate corner as recited in claims 1 and 12. Applicant is very familiar with the Miller '681 reference in that the inventor of the present application is the named inventor in Miller '681. In cols. 1 and 2 of Miller '681, several disadvantages of prior art dispenser openings located in the end wall or bottom forward corner of the carton are discussed (col. 1, ln. 51 through col. 2, line 28). Accordingly, the paramount objective of the invention disclosed in Miller '681 was to provide a carton dispenser to overcome the stated problems with dispensers located in the end wall or bottom corner region of the carton. This objective of Miller '681 was accomplished by a dispenser in either or both of the two side walls of the carton and by not destroying any portion of the end walls or top or bottom walls of the carton (col. 2, lns. 33-40).

Clearly, Miller '681 teaches that dispensers in the forward bottom corner or end wall of the carton are problematic and should be avoided. Miller '681 teaches away from a dispenser opening which is at least in part defined by tear line through the end wall as in claims 1 and 12. A person of ordinary skill upon reading Miller '681 would be discouraged from following such a path or would be led away from a dispenser opening defined in the end wall. *See In re Gurley*, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994).

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As such, Applicant respectfully asserts that one of ordinary skill in the art would not be led to combine Farquhar '283 and Miller '681 as suggested in the rejection to result in a dispenser opening in the end wall of the carton because Miller '681 clearly and unambiguously teaches away from such an invention. As a result, Applicant respectfully asserts that claims 1 and 12, each of which include the feature of a dispenser opening formed by a tear line extending through the end wall adjacent the arcuate corner of the carton, are both novel and non-obvious and a *prima facie* case of non-obviousness has not been established. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection.

As a result of the amendments to the claims and the remarks given herein, applicant respectfully asserts that claims 1-30 as presented herein are in condition for allowance and request notification of same at the Examiner's earliest convenience. If the Examiner feels that any matter in this case requires further

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attention prior to issuing a Notice of Allowance, he is respectfully asked to telephone
the undersigned attorney so that the matter may be promptly resolved.

Respectfully submitted,

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